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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,092	12/29/2003	Takafumi Kondou	64159-Z CCD	6904
7590 07/13/2005			EXAMINER	
Christopher C. Dunham c/o Cooper & Dunham LLP 1185 Ave. of the Americas New York, NY 10036			HOOK, JAMES F	
			ART UNIT	PAPER NUMBER
			3754	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/748,092	<b>Applicant(s)</b> KONDOU ET AL.	
	<b>Examiner</b> James F. Hook	<b>Art Unit</b> 3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.  
2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-41 is/are pending in the application.  
4a) Of the above claim(s) 30-33 and 39 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 21-29, 34-38, 40 and 41 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12-29-03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of figure 4A in the reply filed on April 25, 2005 is acknowledged. It is noted that claim 1 is considered to be generic, however, claim 1 has been canceled. If one were to consider claim 21 to be generic, it must be so for all species, not just a large number of them, therefore, it is not clear that claim 21 is generic to all species at this time since there appear to be species which would not have all of the features of claim 21 in common.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-25, and 27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-6 of U.S. Patent No. 6,601,427 in view of Shepherd. The 427 patent discloses all of the recited structure with the exception of providing a male and female caulking portion along the longitudinal seam to hold the seam closed. The patent to Shepherd discloses that it is

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old and known to use male and female caulking portions along a longitudinal seam to hold the seam closed as suggested by Shepherd where such would allow for a secure yet simple method of holding the sheet in tubular shape without the need of welding or other means which would require more steps and machinery which would cost more money.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 35, line 8, the word "them" is indefinite when it is not clear what them refers to when there are two different possible meanings for the word them, such could either be referring to the male/female portions, or to the first and second edge sections, thereby rendering the claim indefinite where the scope of the claim cannot be easily determined with respect to what the term "them" is referring to structurally.

Claims 21-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support found in the specification for the term "one space" found in claim 21, where it is not clear if such is found in the

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figures when it is not clear where this space is located and what in the figure could be considered the claimed space, therefore if such is not new matter, applicant should provide the specification with support for this terminology at least including pointing out in the drawings what is considered the claimed one space. It should be noted that due to the length of the specification, and the election made, only the specification relating to the elected species was checked for compliance with the claimed subject matter and basis therefore, if applicant has a clear recitation already in another part of the specification the examiner requests such be pointed out in any response to this office action so that the new matter rejection can be dropped.

Claims 21-28 and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support found in the specification for the term "laterally" found in claim 21 or lateral in claim 35, where it is not clear if such is found in the figures when it is not clear in what manner these spaces or clearances are laterally spaced, therefore if such is not new matter, applicant should provide the specification with support for this terminology at least including pointing out in the drawings what is considered the lateral direction or else a description of lateral to what direction. It should be noted that due to the length of the specification, and the election made, only the specification relating to the elected species was checked for compliance with the claimed subject matter and basis therefore, if applicant has a clear recitation

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already in another part of the specification the examiner requests such be pointed out in any response to this office action so that the new matter rejection can be dropped.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21, 28, 35, 37, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by England. The patent to England discloses the recited metal pipe comprising a bent metal plate 3 having first and second edge sections 10 and 11 in opposed and engaged position, a male portion 5 shown with curved end space, a female portion 9, the male and female portions engage each other and being locked together in a caulked portion formed by caulking with deformation of at least one of the members, where the cupped end of the male portion as shown in figure 4 provides a space which is lateral to the male and female portions along the sides as well as at the end, where such is also considered a clearance, as well as the method steps are inherent to the product by process claims where in a product by process claim is limited to only the material affects of the method steps on the structure of the final product.

Claims 21, 28, 35, 37, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Saurenman. The patent to Saurenman discloses the recited metal pipe comprising a bent metal plate 20 having first and second edge sections near 27 and 28 in opposed and engaged position, a male portion 40 shown with curved end and side

space in figures 13-15, a female portion 30, the male and female portions engage each other and being locked together in a caulked portion formed by caulking with deformation of at least one of the members, where the cupped end of the male portion as shown in the figures above provides a space which is lateral to the male and female portions along the sides as well as at the end, where such is also considered a clearance, as well as the method steps are inherent to the product by process claims where in a product by process claim is limited to only the material affects of the method steps on the structure of the final product.

Claims 29, 36, 38, and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Shepherd. The patent to Shepherd discloses the recited metal pipe comprising a bent metal plate 1 comprising parallel first and second edge sections as seen in figure 3, a male portion formed of a pair of divided pieces 5, a female portion formed on a second edge with a back portion that has a space in a back portion that broadens from the open end to the back of the open space, the back portion provided with a projection 4, where the pair of divided pieces are inserted in the space and a clearance is provided therein as seen in figure 3, and the divided pieces are deformed in a mutually spaced direction allowing the divided pieces to engage engaging walls of the female portion, as well as the method steps are inherent to the product by process claims where in a product by process claim is limited to only the material affects of the method steps on the structure of the final product.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over England or Saurenman in view of Crowley. The patents to England and Saurenman disclose all of the recited structure with the exception of forming the pipe in a square shape having four walls. The patent to Crowley discloses that it is old and well known in the art to form metal pipes with longitudinal seams that can be various shapes including one with rounded sides similar to a circular shape as seen in figure 22, or a square shape as shown in figure 19. It would have been obvious to one skilled in the art to modify the shape of the pipe in England and Saurenman to be of any shape including square with four walls as suggested by Crowley where such is merely a choice of mechanical design to change the shape of a pipe, where Crowley teaches the equivalence of forming seamed pipes with rounded end walls to form an oval or similar shape to a circular pipe, and squared shapes with four sides.

Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over England or Saurenman.

Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over England or Saurenman in view of Crowley as applied to claims 22 and 23 above, and further in view of Vance. The patents to England and Saurenman as modified disclose all of the recited structure with the exception of providing a spring back force in one wall



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by forming a concave, convex or restricted wall to create such force, however a spring back force is considered inherent to the material. The patent to Vance discloses that it is old and well known to provide a wall with a convex or concave portion depending upon which direction the wall is considered from opposite to the longitudinal slit as an intermediate step to forming a longitudinally seamed pipe, and where such would inherently create a spring back force. It would have been obvious to one skilled in the art to modify the pipes in England or Saurenman as modified by providing a spring back force during formation of the pipe by using a concave or convex portion as suggested by Vance where such is a known method to form longitudinally seamed pipes where such a method step in an article claim teaches nothing more than how the shape was arrived at or an intermediate step as taught by Vance, where the formed pipe inherently would have some spring back force inherently based upon the material which inherently has a spring back force.

### ***Conclusion***

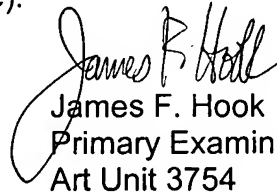
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Black, De Gain, Mori, and Hjertman (076 and 414) disclosing state of the art seamed pipes with connection means such as male and female members.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Wednesday, work at home Thursdays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (571) 272-4906. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
James F. Hook  
Primary Examiner  
Art Unit 3754

JFH